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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/192,273	11/16/1998	DOREE D. SELIGMANN	2925-110P	9569

30594 7590 08/12/2003
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EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 08/12/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/192,273

Applicant(s)
Doree Seligmann

Examiner
Kenneth R. Coulter

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2141



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 3, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. The declaration filed on 6/3/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the Wang et al. (U.S. Pat. No. 6,161,134) reference.

2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Wang reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The evidence is merely a header page from a facsimile.

The contents of the draft facsimile are described as a draft of the application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1 - 51 are rejected under 35 U.S.C. 102(e) as being disclosed by Wang et al. (U.S. Pat. No. 6,161,134) (Method, Apparatus and Communications System for Companion Information and Network Appliances).

4.1 Regarding claim 1, Wang discloses a method of operating a Personal Digital Assistant (PDA), comprising the steps of:

arranging information within the PDA to correspond to at least one of first and second data sets, the first data set including phone features of a user (Abstract; Fig. 3C), at least one of the phone features being set up in the telecommunication system for the user (col. 18, lines 36 - 42; col. 42, lines 20 - 27), the second set including phone policies of the user (Abstract; Figs. 30, 31; col. 42, lines 20 - 27); and

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downloading at least a portion of the arranged information to an IP phone device, the arranged information including at least one of the features and the at least one of the policies (Abstract; Fig. 3C).

4.2 Per claim 2, Wang teaches that said arranging step includes the steps of:

storing a list of predetermined phone features in the PDA (col. 3, lines 41 - 56; col. 37, lines 14 - 27); and

selecting, in the PDA, certain phone features from the list of predetermined phone features to arrange the information (Figs. 26, 27, 30, 31).

4.3 Regarding claim 3, Wang discloses that said operating step includes the step of:

synchronizing the PDA with the IP phone device (col. 9, lines 32 - 41; col. 37, lines 14 - 27).

4.4 Per claim 4, Wang discloses a method of operating a Personal Digital Assistant (PDA) with an Internet Protocol (IP) phone device, comprising the steps of:

arranging information within the PDA to correspond to at least one of first and second data sets, the first data set including phone features of a user (Abstract; Fig. 3C), the second set including phone policies of the user (Abstract; Figs. 30, 31; col. 10, lines 9 - 25; col. 42, lines 20 - 27);

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operating the IP phone device according to the arranged information (Abstract; Fig. 3C);
prestoring identity information of the user in the PDA (col. 3, lines 41 - 52; col. 13, lines 4
- 15); and

verifying, in the PDA, the identity of a current user based on the prestored identity
information (Fig. 33; col. 3, lines 41 - 52; col. 13, lines 4 - 15; col. 42, lines 20 - 27, 34 - 39).

4.5 Regarding claim 5, Wang discloses that said operating step includes the step of:
receiving and initiating calls through the IP phone device according to the arranged
information from said arranging step (Abstract; col. 2, lines 6 - 19; col. 42, lines 20 - 27).

4.6 Regarding claim 6, Wang discloses modifying the arranged information of said arranging
step (Fig. 32; col. 3, lines 41 - 52; col. 13, lines 4 - 15).

4.7 Per claim 7, Wang teaches the PDA includes a phone application program interface (API)
for interfacing the PDA with phone functionality of the IP phone device (Fig. 3A; col. 9, lines 32 -
36).

4.8 Regarding claim 8, Wang discloses in said arranging step, the PDA includes a
feature/policy application program interface (API) for interfacing the PDA with the phone

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features and phone policies of the user (Fig. 3A; Fig. 3C, item 336; col. 20, lines 49 - 60; col. 9, lines 32 - 36).

4.9 Per claim 9, Wang teaches connecting the PDA to an Internet Protocol-Public Branch Exchange (IP-PBX) via the IP phone device (Fig. 2; col. 11, lines 14 - 21).

4.10 Regarding claims 10 - 51, the previous rejection of claims 1 - 9 under 35 USC 102(e) (paragraphs 4.1 - 4.9 above) applies fully.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Coulter whose telephone number is (703) 305-8447.

KENNETH R. COULTER
PRIMARY EXAMINER



krc

August 11, 2003